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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/894,211

07/30/97

HAMMER

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2036.018PCT

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PM82/0119

EXAMINER

LEVISOHN LERNER BERGER & LANGSAM

757 THIRD AVENUE

NEW YORK NY 10017

KNIGHT, A

ART UNIT	PAPER NUMBER
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3626

DATE MAILED:

01/19/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/894,211

Applicant(s)

HAMMER, MORDECHAI

Examiner

Anthony Knight

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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This office action is in response to the amendment filed December 21, 2000 and the personnel interview held November 21, 2000. Applicant's representative stated in the interview that the final rejection mailed July 21, 2000 was premature. The finality of the previous office action is withdrawn. A new action on the merits appears below.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the phrase "hand-holdable" is not described in the specification. Applicant has not provided any basis for the interpretation of this phrase in the specification.

Claims 1-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s),

at the time the application was filed, had possession of the claimed invention.

The specification does not set forth a description of the phrase "hand-holdable".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear from the claims how the phrase "hand-holdable" should be interpreted. Given applicant's disclosure of a myriad of objects from vacuum cleaner wands to sail boat masts. It is not clear whether "hand-holdable" should be interpreted as any object that can be held with outstretched hands, such as, the large sail boat mast or is the phrase limiting the claims to those inventions that fit within the palm of a single hand?

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-3, 5, 8, 16-18, 36, 38, 41, 42, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pipes, U.S. Patent No. 4,388,033 in view of Wilding, U.S. Patent No. 5,040,941. Pipes discloses a motion transmission and multiplication system (10) comprising: at least first 12 and second 14 elements extending in the same orientation; and at least a first means

62 linking said first 12 and second 14 elements and being movable with respect to at least one of them, said first linking means 62 being arranged on said first element 12 such that when said first linking means 62 is provided with a driving motion (by pinion 22) in a direction of said orientation, said first 12 and second 14 elements are provided with a driven motion with respect to each other. First element 12 telescopically receives second element 14 and first linking means 62 is a flexible member. The speed control is the motor. Third element 16 is telescopically received in the second element 14. Linking means 62 is enclosed in the first element 12. Rollers (35, 43, 51, 57) guide the elements in tracks (36, 44, 52, 58). System 10 is a conveyor. The room that the system is used in can be illuminated. A toy is anything that can be used for amusement. Any object can be a toy since it depends upon the intent of the person using the device. The movement of the conveyer is not dependent upon gravity. Pipes does not disclose that the motion is controllably reversible. Wilding teaches the use of a controller 25 for the purpose of controlling the movement of a conveyer 30 for the purpose maintaining consistent movement of the product being conveyed. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the device of Pipes as taught by Wilding for the purpose of maintaining consistent movement of the product being conveyed.

Claims 1-3, 5, 8-12, 16-19, 23, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over White, U.S. Patent No, 1,456,478 in view of Wilding. White discloses a motion transmission and multiplication system comprising: at least first 20 and second 23 elements extending in the same

orientation; and at least a first flexible means 43 linking said first 20 and second 23 elements and being movable with respect to at least one of them, said first flexible linking means 43 being arranged on said first element 20 such that when said first flexible linking means 43 is provided with a driving motion (by gearwheels 46, 48) in a direction of said orientation, said first 20 and second 23 elements are provided with a driven motion with respect to each other. First 20 and second 23 elements are rigid and telescope in side-by-side tracks. The first, second and third elements are rigid and driven by screw 16. First 20, second 23, and third 24 elements are shutters. White does not disclose the use of a controller. Wilding teaches the use of a controller 25 for the purpose of controlling the movement of a linear device (conveyer 30) for the purpose maintaining consistent movement of the product being conveyed. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the device of White as taught by Wilding for the purpose of maintaining consistent movement of the device.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Wilding as applied to claims 1-3, 5, 8-12, 16-19, 23, and 40 above, and further in view of Sandberg, U.S. Patent No. 326,336. White in view of Whiting, as set forth above, discloses all of the claimed invention except that the driving motion is provided by hand. Sandberg teaches the use of a hand crank G for the purpose of allowing hand operation of an extendible member. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the device of White in view of Wilding and further

in view of Sandberg to incorporate a hand crank for the purpose of allowing hand operation of the device.

Claims 6, 7, 13-15, 19-22, 25-35, 37, 39, 43, 44, 46, 48, and 49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The reference of Curtis is cited to show a controller.

RESPONSE TO APPLICANT'S ARGUMENTS

Applicant's argument that the Steidle reference is gravity dependent for the reverse motion of the telescopic member is persuasive and the rejections based upon this reference are withdrawn. However, applicant insist on arguing for claims of a scope that are not patentable. The claims are considered to be an obvious variant of Pipes. As stated in the office action mailed July 21, 2000, the reference of Pipes did not explicit disclose a reversibly controllable device it was not conceded that the reference of Pipes couldn't be modified to include a controller.

Applicant argues in the amendment filed April 30, 1999 that Pipes does not disclose telescopic members that are nested. This limitation is not set forth in claim 1 and in fact claim 38, which depends from claim 1, sets forth that the first and second elements are moveable side-by-side. Claim 1 is silent as to the exact position of the members relative to each other.

Pipes discloses members that move with the linking means. It is the movement of Pipes linking means that causes the movement of the elements.

Applicant's argument concerning the practical applications being different is not understood. Applicant has argued that his invention can be used in almost any situation where an extensible device is need. Accordingly, any device that is extensible is considered to be applicant's field of endeavor.

Pipes does not disclose the use of a controller to control the movement of the conveyer. Wilding discloses the use of a controller to control the movement of a conveyer for the purpose of maintaining a consistent discharge of products from the conveyer. As set forth above, one having ordinary skill in the art would thus find the invention obvious.

Applicant argues that White does not disclose the nesting of the telescopic elements. This argument is not understood. As clearly shown in the figures, the elements are nested one inside of the other. Furthermore, this is not a limitation contained in claim 1 and is not set forth until a later dependent claim. Applicant's argument that the linking means is not contained within the elements is not understood. As clearly shown in Figures 1 and 2, the linking means 43 is within the telescopic elements 20, 23, 24, and 25. White does not disclose a controller. Wilding is relied upon for the teaching of a controller for a linear member. The fact that a hand crank can be used instead of a motor is not considered to be a patentable difference.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Knight whose telephone number is (703) 308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 305-3598 for After Final communications.

AK
January 12, 2001



Anthony Knight
Supervisory Patent Examiner
Group 3600